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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,914	03/08/2002	Ben Herbert	FBRIC29.001APC	2992
20995	7590	06/04/2004		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
			EXAMINER DIAMOND, ALAN D	
			ART UNIT 1753	PAPER NUMBER

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,914

Applicant(s)

HERBERT, BEN

Examiner

Alan Diamond

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09112002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference sign 23, which appears on page 5 at line 19, and on page 6 at line 1. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: reference sign 43 in Figures 4a and 4b. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 14 is objected to because of the following informalities: Claim 14 is missing a period at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is not clear which of the electrode areas is being referred to by the term "the electrode area" at line 6. It is suggested that said term be changed to "the electrode areas". Note at lines 4-5 of claim 1 that there is an electrode area disposed either side of the rehydration area. The same applies to dependent claims 2-13. In particular, in claim 2, at line 2, the term "electrode area" should be changed to "electrode areas", and in claim 7, at line 1, the term "electrode area is" should be changed to "electrode areas are".

Claim 1 is indefinite because the term "the first and second end" at line 9 lacks positive antecedent support in claim 1 itself. It is suggested that said term be changed to "a first and second end". The same applies to dependent claims 2-13.

In claim 1, at line 12, the term "the strip" should be changed to "the gel strip" so as to clearly point out which strip is being referred to. The same applies to dependent claims 2-13.

Claim 4 is indefinite because "the delimiting wall" at line 2 lacks positive antecedent support in claim 3 and in claim 1. The same applies to dependent claims 5 and 6.

Claim 5 is indefinite because "the electrode bridges" at line 1 lack positive antecedent support in claims 4, 3, and 1. The same applies to dependent claim 6.

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Claim 13 provides for the use of the apparatus according to any of the preceding claims, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 14 is indefinite because "the bridges" at line 8 and "the electrode bridges" at lines 12-13 lack positive antecedent support in claim 14 itself. The same applies to dependent claim 15.

Claim 16 is indefinite because "the electrode area" at each of lines 7 and 9 lacks positive antecedent support in claim 16 itself. Furthermore, it is not clear exactly where "the electrode area" is present in the apparatus. It is suggested that the term "the electrode area" at line 7 be changed to "an electrode area of the electrode trough". Then, at line 9, the term "the trough" should be changed to "the electrode trough".

Claim 16 is indefinite because it is not clear which trough is being referred to by the term "the trough" at line 9. As noted in the immediately preceding paragraph, the term "the trough" at line 9 should be changed to "the electrode trough".

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 13 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under

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35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5 and 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaplan et al, U.S. Patent 4,151,065.

Kaplan et al's slab gel electrophoresis apparatus has a trough (30) configured to receive a gel strip (60) in the central area thereof (see Figures 1-3 and 6; and col. 3, line 34 through col. 4, line 4). This central area reads on the instant rehydration area. Note in Figures 1 and 2 that the electrode areas (74) at either side of the trough are delimited from the trough. Note also that there are wicks (20, 22) which are a bridge material providing contact with the gel. Note in Figures 1 and 2 that there are lateral walls (26, 28) that separate the central area of the trough from the electrode area, and that the electrode area is deeper than the central area. Note in Figure 4 that there can be partitions (35) that partition the gel (60) into several horizontal slab (see also col. 5, lines 7-15). Since Kaplan et al teaches the limitations of the instant claims, the reference is deemed to be anticipatory.

10. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al, WO 99/33550.

Williams et al's electrophoresis apparatus has tray (11) containing parallel troughs (14); and electrodes (43) disposed on the frames (41, 42) near either end of the tray (11) (see Figure 1 and 2; and pages 5-6). A paper wick, which reads on the instant electrode bridge material, is used to provide contact between the gel and the electrodes (see page 9, lines 21-32). Since Williams et al teaches the limitations of the instant claims, the reference is deemed to be anticipatory.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patents and Patent Application Publications 4,391,688, 4,415,418, 4,666,581, 2002/0100690, 2003/0015426, 2003/0221962, and 2004/0045829 are hereby made of record.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is 571-272-1338. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

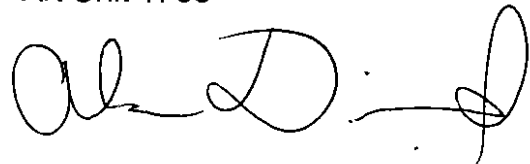
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alan Diamond
Primary Examiner
Art Unit 1753

Alan Diamond
May 20, 2004

A handwritten signature in black ink, appearing to read 'Alan Diamond', with a stylized flourish at the end.